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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,667	06/29/2001	Koichiro Akiyama	210683US2SRD	9366
22850	7590	02/02/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GREENE, DANIEL L	
		ART UNIT		PAPER NUMBER
		3621		

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/893,667	AKIYAMA, KOICHIRO
	<b>Examiner</b>	<b>Art Unit</b>
	Daniel L. Greene	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 November 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/01,11/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

The Amendment under 37 CFR 1.132 filed 11/8/2004 is insufficient to overcome the rejection of claims 1, 2, 3, 6, 9, 10, 17, 18 and 21 based upon Kambayashi as set forth in the last Office action because: The Applicant states that Kambayashi fails to disclose or suggest “ sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated.” The Claims 1, 2, 3, 6, 9, 10, 17, 18 and 21 are rejected under 35 U.S.C. 103 as being unpatentable over Kambayashi. Kambayashi teaches all of the elements claimed with the exception of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated. The examiner takes Official Notice that sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated because the skilled artisan would have recognized that this business practice of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a

record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As per claim 19, lines 20-21, and claim 20, lines 9-10, the statement, "required to decrypt encrypted contents information", appears to associate with the first distributor. Prior to claim 19, the decrypting was associated with the receiver. The Examiner requests the Applicant to stipulate where in the Specifications this limitation of the first distributor is required to decrypt encrypted contents.

3. The reply filed on 11/8/2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The Examiner requested the

Applicant to stipulate where in the Specifications this limitation of the first distributor is required to decrypt encrypted contents.

***Double Patenting***

1. Applicant is advised that should claims 19 and 20 be found allowable, claims 19 and 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambayashi et al. U.S. Patent 6,477,649 [Kambayashi].

3. As per claims 1, 2, 3, 6, 9, 10, 11, and 14:

The recitations, a broadcast receiving method, a broadcast receiving apparatus, a method of distributing information, and an information distributing apparatus, has not

been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

Kambayashi discloses:

storing first control information in a storage device of a receiver, the first control information containing identification information unique to the receiver and contract information and required for the receiver to select broadcasted and encrypted contents information; Col. 11-12, lines 1-67.

receiving second control information with the receiver via a bi-directional communications channel, the second control information containing information for updating; Col. 38, lines 1-67.

periodically updating the contract information of the first control information in the storage device to the contract information contained in the second control information; Col. 39, lines 33-67.

receiving broadcasted key information independent from the receiver and required to decrypt the contents information; Col. 41, lines 33-67.

selecting and decrypting the contents information based on the key information and updated contract information of the first control information. Col. 42, lines 30-67.

Kambayashi teaches all of the elements claimed with the exception of sending back a receipt acknowledgement from the receiver via the bi-directional communication

channel when the contract information of the first control information is updated. The examiner takes Official Notice that sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated because the skilled artisan would have recognized that this business practice of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

Kambayashi does not expressly show that a bi-directional communications channel sends the data. However, Kambayashi does teach transferring information through a network such as the Internet or by broadcasting. Col. 14, lines 53-56. The Examiner submits that a person having ordinary skill in the art would have known that the Internet is a bi-directional communications channel.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The receiving of the information would still be accomplished whether the medium used was a bi-directional channel,

Internet, telephone, etc. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit the information utilizing any medium available because such medium does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 4, 7, 12, and 15:

Kambayashi further discloses:

wherein the first receiver receives the second control information after the broadcast receiving apparatus is certified by the first distributor. Col. 65, lines 1-26.

As per claims 5, 8, 13, and 16:

Kambayashi further discloses:

wherein said first receiver sends a use history required to charge a fee for use of the contents information to the first distributor, and then receives the second control information. Col. 57, lines 35-67.

As per claims 17 and 18:

Kambayashi further discloses:

broadcasting key information to the receiver from a distributor, the key information being independent from the receiver and required to decrypt encrypted contents information, the receiver selecting and decrypting the contents information based on first control information and the key information, the first control information containing identification information unique to the receiver and required to select the contents information; Col. 11-12, lines 1-67.

distributing second control information to the receiver via a bi-directional communications channel, the second control information being for updating at least some contents of the first control information in the receiver; Col. 38, lines 1-67.

broadcasting the individual control information if receipt of the individual control information is not confirmed by the receiver. Col. 65, lines 1-67.

Kambayashi teaches all of the elements claimed with the exception of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated. The examiner takes Official Notice that sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract

information of the first control information is updated because the skilled artisan would have recognized that this business practice of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

As per claim 21:

Kambayashi discloses the claimed invention except for "a second receiver". It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have more than one receiver, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

*St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.*

a storage device configured to store first control information required to decrypt broadcasted and encrypted contents information; Col. 11-12, lines 1-67.

a first receiver configured to receive second control information distributed from the first distributor via a bi-directional communication channel, the second control information containing contract information used to update at least contract information of the first control information stored in the storage device or broadcasted by the first distributor; Col. 38, lines 1-67.

a transmitter configured to transmit receipt of the information when the first receiver receives the second control information via the bi-directional communications channel; Col. 57, lines 35-67.

an update device configured to periodically update the contract information of the first control information in the storage device to the contract information of the second control information received by the first receiver; Col. 39, lines 33-67.

a second receiver configured to receive key information broadcasted by the second distributor, the key information being required to decrypt the encrypted contents information and common to a plurality of broadcast receiving apparatuses, Col. 41, lines 33-67

wherein the contents information is decrypted based on the decrypt control information stored in the storage device and the key information received by the second receiver. Col. 42, lines 30-67.

Kambayashi teaches all of the elements claimed with the exception of a certifying device configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated. The examiner takes Official Notice that a certifying device configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of a certifying device configured to send back a

receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated because the skilled artisan would have recognized that this business practice of a certifying device configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene  
Examiner  
Art Unit 3621

1/26/2005

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